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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,137	06/15/2001	Mark L. Nelson	GAZ-065CP	8277

959 7590 04/24/2003

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER

BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 04/24/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,137

Applicant(s)

NELSON ET AL.

Examiner

Barbara P. Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30,32-45 and 47-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30,32-45 and 47-64 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Final Office Action on the Merits

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

2. The rejection of claims 28-30 under 35 USC 112, second paragraph is withdrawn.

Double Patenting

3. The provisional rejection of claims 10-15 and 17-29 under 35 USC 101 as claiming the same invention as that of claims 3-9, 11-17, 19-23, 25 and 29 of copending Application No. 09/882,273 is maintained.

Applicant argues the compositions of copending Application No. 09/882,273 are not directed to compositions that are substantially free of positional isomers as claimed by the instant invention. Applicant's argument was considered but not persuasive for the following reason.

The claims of copending Application No. 09/882,273 are read in light of its disclosure. According to said disclosure, the compounds are purified by methods known in the art, thus, the compounds of copending Application No. 09/882,273 are inclusive of compounds that are substantially free of positional isomers.

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For this reason and those given in Paper No. 6, the provisional rejection of claims 10-15 and 17-29 under 35 USC 101 as claiming the same invention as that of claims 3-9, 11-17, 19-23, 25 and 29 of copending Application No. 09/882,273 is maintained.

4. The provisional rejection of claims 3, 5, 7, 9, 39 and 41 under 35 USC 101 as claiming the same invention as that of claims 3, 6, 8, 10, 29 and 30 of copending Application No. 09/882,505 is maintained.

Applicant's argument and the examiner's response are as discussed above in #3.

5. The provisional rejection of claims 1, 2, 4, 6, 10-30, 32-38 and 40-45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 09/882,273 is maintained.

Applicant states the provisional rejection will be addressed upon a finding of allowable subject matter in the instant application.

6. The provisional rejection of claims 1-9, 32-45 and 47-64 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 09/882,505 is maintained.

Applicant states the provisional rejection will be addressed upon a finding of allowable subject matter in the instant application.

7. The provisional rejection of claim 46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 09/882,505 is made moot by the cancellation of the instant claim.

Claim Rejections - 35 USC § 102

8. The rejection of claims 1-4, 8, 9, 24-30 and 58-64 under 35 USC 102(b) over Koza is maintained.

Applicant argues the reference does not teach or suggest compositions that are substantially free from positional isomers. Applicant's argument was not persuasive for the following reasons.

The use of the phrase "substantially free" does not imply the claimed composition does not contain positional isomers. Therefore, even if the reference does not teach a composition substantially free from positional isomers, the prior art composition would be encompassed by the instant claims. However, according to Koza, the product of the prior art does not contain significant side products (see page 816, col. 1, paragraph #3). Thus, the prior art compounds/compositions are encompassed by the instant claims.

For these reasons and those given in Paper No. 6, the rejection of claims 1-4, 8, 9, 24-30 and 58-64 under 35 USC 102(b) over Koza is maintained.

Claim Rejections - 35 USC § 103

9. **The rejection of claims 1-30, 32-45 and 47-64 under 35 USC 103(a) over Koza is maintained.**

Applicant's argument and the examiner's response are as discussed above #8.

Other Matters

10. The examiner notes the typographical errors made in paragraphs 5 and 8 of the previous Office Action. In paragraph 5, claim 31 should read 41 and in paragraph 8, claims 31-64 should read claims 32-64.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

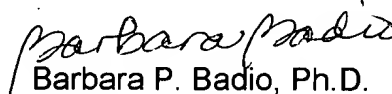
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T I phon Inquiry

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Barbara P. Badio, Ph.D.
Primary Examiner
Art Unit 1616

BB
April 23, 2003